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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,990	04/19/2004	Bryan M. Buchi	3053.2.1	3498

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EXAMINER

CAJILIG, CHRISTINE T

ART UNIT	PAPER NUMBER
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3637

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/08/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/826,990

Applicant(s)

BUCHI, BRYAN M.

Examiner

Christine T. Cajilig

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-11 and 21-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-11 and 21-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/05/06 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 21, and accordingly, dependent claims 2-6 and 22-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The language of "liner consisting essentially of" is deemed new matter and has not been originally claimed or disclosed. There is absent of indication in the specification that the additional steps or components would materially change the characteristics of Applicant's invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5-6, 21, and 24-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 5, 6, 21, 24, and 25 positively recite a window well and screws. It is unclear whether the claims are directed to a liner per se, or a liner in combination with a window well. The preamble of the claims 1 and 21 dictates that the claim is directed toward a liner. Thus, any recitation of the window well or any structure that is considered not part of a liner (i.e. window well, screws), which is not phrased as an "adapted to" or functional language, renders the scope of the claim to be indefinite. Therefore, for purposes of examination, the Examiner interprets the claims to be directed only to the article, which is a liner, and any recitation of other elements that does not constitute the liner is not given any patentable weight.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent,

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except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Scott et al. (U.S. Patent No. 5,268,137).

Regarding claim 1, Scott et al. in Figures 3 and 6 discloses a liner consisting essentially of a flexible first side (62) with a three-dimensional pattern (T,B) protruding therefrom, a flexible second side (30) that is substantially flat and configured to contact a window well; and wherein the liner is a flat and single contiguous sheet that is elastically flexible (as shown in Figure 3) and configured to attach to a window well. No patentable weight is given to the recitation of a window well.

Regarding claim 2, Scott et al. discloses the liner as discussed above and further discloses that the first side comprises a pattern of artificial rocks (as better shown in Figure 3) designed to give an appearance of a rock wall.

Regarding claim 3, Scott et al. discloses the liner as discussed above and further discloses that the liner is comprised of polyurethane (Col 6, Ln 13-19).

Regarding claims 5 and 6, Scott et al. discloses the liner as discussed above and further discloses that the liner is capable of being secured with screws to a window well or any other supporting structures and wherein the screws pass through the liner and into a proud section of a window well or any other supporting structure because the liner of Scott et al. is capable of being nailed onto a vertical form (Col 6, Ln 64-68).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Groves (U. S. Patent No. 5,647,154) in view of Bryant et al. (US 2004/0035063).

Regarding claim 1, Groves in Figure 5 discloses a liner consisting essentially of a flexible first side (36), a flexible second side (the side opposite of 36 where 31 is affixed) that is substantially flat and configured to contact a window well; and wherein the liner is a flat and single contiguous sheet that is elastically flexible (as shown in Figure 5) and configured to attach to a window well, but does not disclose that the first flexible side has a three-dimensional pattern protruding therefrom. However, Bryant et al. discloses a liner (102) with a three-dimensional pattern (202, 206) protruding from a surface.

Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the Applicant's invention modify the well shield Groves to have a three-dimensional pattern protruding from the first side as taught by Bryant et al. to provide a decorative rock pattern that would suit a consumer's design preference. Furthermore, it has been held that "matters relating to ornamentation only which have no mechanical

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function cannot be relied upon to patentably distinguish the claimed invention from the prior art." *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). Providing a three-dimensional pattern on a surface is an aesthetic design change (i.e., ornamentation only) that would require only ordinary skill in the art, and thus, would have been obvious. No patentable weight is given to the recitation of a window well.

Regarding claim 2, Groves already modified by Bryant discloses the liner as discussed above and further discloses that the first side comprises a pattern of artificial rocks designed to give an appearance of a rock wall per the modification in claim 1.

Regarding claim 3, Groves already modified by Bryant discloses the liner as discussed above but does not disclose that the liner is comprised of polyurethane (Col 6, Ln 13-19). It would have been obvious to one having ordinary skill in the art at the time of invention to make the window well shield of polyurethane, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claims 5 and 6, Groves already modified by Bryant discloses the liner as discussed above but does not disclose that that the liner is capable of being secured with screws to a window well or any other supporting structures and wherein the screws pass through the liner and into a proud section of a window well. However, Bryant also discloses that a liner is capable of being secured to a supporting structure (104) with screws (210). Therefore, it would have been obvious to a person having ordinary skill in

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the arts at the time of the Applicant's invention to be able to penetrate the lining of Groves with screws as demonstrated by Bryant et al. to securely fasten a liner.

Claims 7, 9, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bryant et al. (US 2004/0035063) in view of Poole (U.S. Patent No. 6,484,455 B1).

Regarding claims 7, Bryant in Figure 2 discloses a single sheet window well liner (102) having a three-dimensional pattern (206) secured to an inside surface of a window well shield (104) but does not disclose that the window well shield is coupled directly to a home. However, it is notoriously well known in the art that window well shields are directly coupled to a home as exemplified by Poole who discloses a window well shield (10) that is directly coupled to a home (52). Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the Applicant's invention modify the well shield of Bryant et al. to be directly coupled to a home as taught by Poole to rigidly secure the window well shield.

Regarding claim 8, Bryant already modified by Poole discloses everything previously mentioned, but does not disclose the window well shield is comprised of polyurethane. It would have been obvious to one having ordinary skill in the art at the time of invention to make the window well shield of polyurethane, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

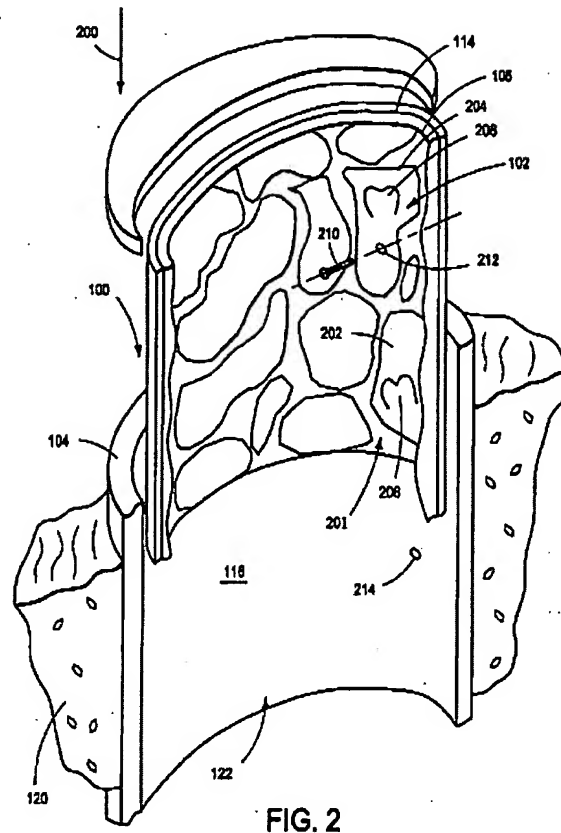
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Regarding claim 9, Bryant already modified by Poole further discloses that the first side (106) comprises a pattern of artificial rocks (108), having round and elliptical shapes.

Regarding claim 11, Bryant already modified by Poole further discloses that the window well shield (102) is secured to a window well (104), with screws (210) that pass through the liner (106, 114) and into a proud section of the window well (104).

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bryant in view of Poole as applied to claim 7 above, and further in view of Rygiel (US 6237294).

Regarding claim 10, Bryant already modified by Poole discloses everything previously mentioned, but does not disclose that the pattern is a series of generally rectangular shaped rocks. Rygiel, however, discloses a decorative panel (10) with rectangular shaped bricks (18). Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to modify the window well shield of Bryant already modified by Poole to include a pattern with rectangular shaped rocks as taught by Rygiel, to have a molded panel with a desired pattern.



Bryant et al. (US 2004/0035063) Figure 2

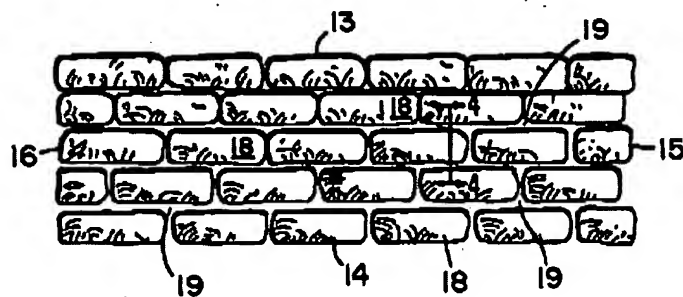


FIG. 3

Rygiel (US 6237294) Figure 3

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Claims 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kemerer et al. (U.S. Patent No. 4,290,248).

Regarding claims 21 and 22, Kemerer et al. in Figure 18 discloses a panel/liner of a single flexible polyurethane sheet (Col 14, Ln 49-57, Col 17, Ln 58-62) having a first side (302) and a second side (the surface on the back side of 302), wherein ornamental protrusions (300) extend from the first side; paint disposed over the first side (Col 7, Ln 9-12); and the second side is substantially free of protrusions (Col 25, Ln 66) and wherein the second side is capable of being coupled directly to a window well, but does not explicitly disclose that the paint is alkyd paint. However, this would obviously include alkyd paint, as alkyd paint is a common oil-based paint, which would be obvious to use to one skilled in the art.

Claim 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kemerer et al. in view of Glover et al. (U.S. Patent No. 6,612,091).

Regarding claim 23, Kemerer et al. discloses everything previously mentioned, but does not disclose a layer providing ultraviolet protection. However, Glover et al. discloses a panel (30) having a UV coating (Col 8, Ln 50-53). Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to modify the panel/liner of Kemerer et al. to include a layer that provides protection from the elements including ultraviolet rays, as this would prevent deterioration of the color (Col 8, Ln 50-53).

Regarding claims 24 and 25, Kemerer et al. already modified by Glover et al. discloses everything previously mentioned and further discloses that the liner is capable of having a plurality of screws disposable through the sheet and wherein paint is disposed over the heads of the plurality of screws.

Regarding claim 25, Kemerer et al. already modified by Glover et al. discloses everything previously mentioned but does not disclose that the single flexible polyurethane sheet is sized to match an associated window well shield. It would have been an obvious matter of design choice to modify the panel/liner of Kemerer et al. already modified by Glover et al. to be sized to match an associated window well shield since such a modification would have involved a mere change in the size of the components and would allow for the panel to be used in any situation. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Response to Arguments

Applicant's arguments with respect to claims 1, 2, 5-7, 9, and 11 have been considered but are moot in view of the new ground(s) of rejection.

Regarding applicant's arguments that the amendments to the claims, which included the limitation that the liner is flexible, are not disclosed by the prior art: The term "flexible" is given the broadest reasonable interpretation of something that is capable of being bent (flexible. (2003). In *The American Heritage® Dictionary of the English Language*). Furthermore, the term "elastic" or elastically is defined as the

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property of being able to return to its original shape after removal of deforming stress (elastic. (1992). In *Academic Press Dictionary of Science and Technology*).

Furthermore, Applicant's reference to paragraph 0036 does not give an explanation that the tuning. Therefore, any element that is capable of deformation is considered flexible.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Yamamoto (U.S. Patent No. 5,213,870) a bendable ornamental panel; Nasvik et al. (U.S. Patent No. 5,632,922) a contoured wall liner; Miller et al. (U.S. Publication No. 2001/0012555 A1) a mold liner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine T. Cajilig whose telephone number is (571) 272-8143. The examiner can normally be reached on Monday - Friday from 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on (571)272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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